



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/843,838	04/30/2001	Hideyuki Ijiri	50212-227	1916
7590 07/30/2004 McDERMOTT, WII & EMERY 600 13th Street, N.W. Washington, DC 20005-3096			EXAMINER HOFFMANN, JOHN M	
			ART UNIT 1731	PAPER NUMBER

DATE MAILED: 07/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/843,838

Applicant(s)

IJIRI ET AL.

Examiner

John Hoffmann

Art Unit

1731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 4,5 and 9-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 4,5 and 9-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8 July 2004 has been entered.

### ***Priority***

Applicant is hereby required to submit sufficient evidence to prove the international application was copending with the U.S. National application claim benefit under 35 USC 120. The authority for Examiner to require such (and an explanation as to how applicant can meet this requirement) is contained in MPEP 1895. >The evidence submitted to prove that the international application was copending with the U.S. national (35 U.S.C. 111(a)) application should include a certification from applicant that neither the international application nor the designation of the United States was withdrawn or considered to be withdrawn prior to the filing date of the U.S. national (35 U.S.C. 111(a)) application.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

Art Unit: 1731

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 18 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is no support for the use of "fuels" – especially the use of hydrogen "fuels". At most, examiner could only find support for using one fuel to create a flame.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4-5, 9, 11, 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hiroo JP 62-167235 in view of any of Kortan 5560759, Oleskevich 5790735 and DiGiovanni 5966491.

See how Hiroo was previously applied.

As to the diameter being at least 14 times that of the core. First see how claim was treated previously. Furthermore: Kortan teaches (col. 6, lines 20-22) ratios of 20 –

200 are preferred for single mode fibers. And Oleskevich col. 4 lines 38- 45 discloses ratios the correspond to ratios of 3.5:1 up to 20:1, and Di Giovanni (col. 4, lines 58-64) discloses area ratios that correspond to diameter ratios of 10:1 to 17:1 are "usual". Having a fiber with a ratio greater than 14 is conventional.

As to the change in the preamble: first it is noted that the since the claim does not recite a step of making a fiber, the preamble does not appear to breathe life and meaning into the claims. However, even if it is, such is merely intended use of the preform. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

It is noted that from Onishi 6502428, Onishi 6076376 and Roba 6371394. That the dispersion characteristics depend upon how the fiber is drawn. Although Applicant discloses a particular type of preform which can be used to create a dispersion compensating fiber, completely different sorts of preforms can be used to make a dispersion compensating fiber. Furthermore, given Applicant discloses a special fiber to compensate for the dispersion of the regular fiber – one can also consider that the regular fiber compensates for the dispersion of the special fiber. It all depends upon which end of the fiber the laser light is introduced. If the light is introduced into the

special fiber first, it imparts dispersion, then when the light exits that special fiber, it then would enter the regular fiber in which case it would reverse (i.e. compensate for) the dispersion of the special fiber. It is noted this is NOT to be interpreted as a statement that one would combine any references or teaches – rather it is to be interpreted as showing that the claims recite an intended use that does NOT result in any structural difference nor in any manipulative difference.

Claim 17: as alluded to above, whether a fiber is a compensating fiber is a matter of perspective and/or use. The best way to demonstrate this is from figure 1 of Onishi 6502428. one portion of the Onishi fiber has a negative dispersion (D2) whereas the other portion has a positive dispersion (D1). One can say that D2 compensates for D1: and one could just as easily (and just as accurately) say that D1 compensates for D2. Likewise regardless of whether the Hiroo fiber has a negative or positive dispersion (see preamble which indicates a dispersion), it could function as a compensator for a fiber which has the opposite polarity. To look at it another way. Applicant's fiber can only compensate for the dispersion in only certain fibers: it cannot compensate for dispersion for all fibers. For example, a fiber that is identical to Applicant fiber.

Claim 18: it would have been obvious to interchange one known heating method for another depending upon which is cheaper.

Claims 10 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hiroo JP 62-167235 in view of any of Kortan 5560759, Oleskevich 5790735 and

DiGiovanni 5966491 and further in view of Berkey 5894537 in view of any of Kortan 5560759, Oleskevich 5790735 and DiGiovanni 5966491.

See the prior Office actions for the manner in which the art is applied.

Claims 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hiroo (or the Hiroo abstract) in view of any of Kortan 5560759, Oleskevich 5790735 and DiGiovanni 5966491 as applied to claim 1 and further in view of Kyoto 5221309.

See the prior Office actions for the manner in which the art is applied.

### ***Response to Arguments***

Applicant's arguments filed 8 July 2004 have been fully considered but they are not persuasive.

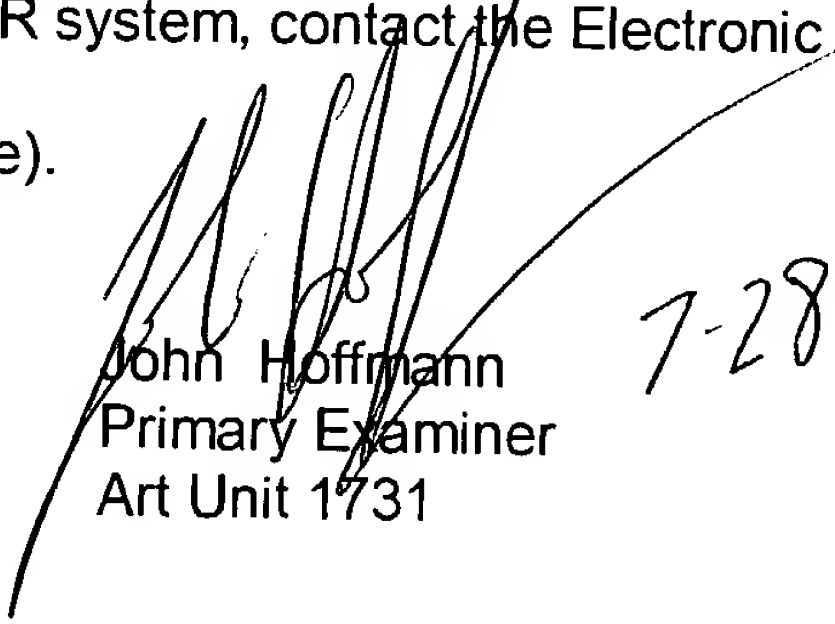
Regarding priority: see the advisory action of June 18 2004 as to why the evidence that Applicant submitted is insufficient to establish that the applications were copending.

Likewise, the rest of the arguments were addressed in the Advisory Action of June 18, 2004. Note: the above rejection also have extra points and evidence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Hoffmann whose telephone number is (571) 272 1191. The examiner can normally be reached on Monday through Friday, 7:00- 3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steve Griffin can be reached on 571-272-1189. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
John Hoffmann  
Primary Examiner  
Art Unit 1731

7-28-04

jmh